

**REMARKS**

Claims 1-4 and 10 are pending in the above application.

The Office Action dated June 2, 2006, has been received and carefully reviewed. In that Office Action, claims 1 and 2 were rejected under 35 U.S.C. 102(e) as being anticipated by WO 03/038001 and under 35 U.S.C. 102(e) as being anticipated by Hakamada. In addition, claims 1, 2 and 10 were rejected under 35 U.S.C. 103(a) as being unpatentable over WO 03/038001, and claims 3 and 4 were rejected under 35 U.S.C. 103(a) as being unpatentable over WO 03/038001 or Hakamada. Reconsideration and allowance of claims 1-4 and 10 is respectfully requested in view of the following remarks.

**REJECTIONS UNDER 35 U.S.C. 102(e)**

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by WO 03/038001. However, page 3 of the Office Action indicates that "WO 03/038001 fails to specifically exemplify a second coloring agent identical in hue to the first coloring agent." In view of this admission that at least one element required by claim 1 is not shown in WO 03/038001, it is respectfully submitted that claim 1 is not anticipated by WO 03/038001, and the withdrawal of this rejection is respectfully requested.

Claim 2 depends from claim 1 and is submitted to be allowable for at least the same reasons as claim 1. Moreover, claim 2 requires a fluorescent coloring agent and a non-fluorescent coloring agent. WO 03/038001 does not disclose a fluorescent coloring agent. Claim 2 is submitted to further distinguish over WO 03/038001 for this reason.

Claim 1 is also rejected under 35 U.S.C. 102(e) as being anticipated by Hakamada. Claim 1 requires, *inter alia*, a recording agent comprising a first coloring agent and a second coloring agent wherein the recording agent has a higher spectral reflectance than a spectral reflectance of the first coloring agent. Hakamada does not discuss the spectral reflectance of the inks or dyes used. The Office Action does not state that Hakamada's inks or dyes have the claimed spectral reflectance required by claim 1. This higher spectral reflectance of the recording medium beneficially increases brightness and/or saturation as discussed in the specification from page 52, line 25 to page 54, line 24. Because Hakamada does not show at

least this limitation of claim 1, claim 1 is submitted to be allowable over Hakamada. If this rejection is maintained, it is respectfully requested that the examiner identify where in Hakamada the claimed spectral reflectances are believed to be shown so that Applicant can better understand the grounds for this rejection.

Claim 2 depends from claim 1 and is submitted to be allowable for at least the same reasons as claim 1.

#### REJECTIONS UNDER 35 U.S.C. 103(a)

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 03/038001. Claim 1 requires, *inter alia*, a recording agent comprising a first coloring agent and a second coloring agent wherein the recording agent has a higher spectral reflectance than a spectral reflectance of the first coloring agent. WO 03/038001 does not discuss the spectral reflectances of the materials used. The Office Action does not indicate where the required spectral reflectances are shown or suggested by WO 03/038001. Claim 1 is submitted to be allowable over WO 03/038001 for at least this reason.

Moreover, Applicant respectfully traverses the statement in the Office Action that only “general conditions” need to be found in the prior art to support a finding of obviousness. The cases cited in the Office Action show that, under some circumstances, mere changes in size, proportion, shape or sequence of adding ingredients may be insufficient to establish non-obviousness. MPEP 2144.04. However, nothing in those cases or the cited section of the MPEP shows supports the broad generalization regarding “general conditions” contained in the Office Action. WO 03/038001 does not show a second coloring agent identical in hue to a first coloring agent along with the other limitations of claim 1, and claim 1 is submitted to be allowable over WO 03/038001.

Claim 2 depends from claim 1 and is submitted to be allowable for at least the same reasons as claim 1. In addition, claim 2 requires the first coloring agent to be a non-fluorescent coloring agent and the second coloring agent to be a fluorescent coloring agent. WO 03/038001 in no manner shows or suggests such coloring agents, and is submitted to further distinguish over this reference for this reason.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 03/038001. Claim 10 includes limitations directed to the spectral reflectances of first and second coloring agents. WO 03/038001 is silent regarding the spectral reflectances of the materials used. Claim 10 is therefore submitted to be allowable over WO 03/038001 for at least the reasons provided above in connection with claim 1.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 03/038001 or Hakamada. Claim 3 requires a ratio between the first and second coloring agents, which ratio is based in part on the spectral reflectances of the first and second coloring agents. Beneficially, the formulas of claims 3 and 4 allow the compounding ratio of  $x$  from a desired color of a recording agent to be predicted. The compounding ratio of  $x$  can be found by carrying out a calculation, with the smallest value given to the color difference in accordance with i) the spectral reflectance  $R_o$  of the first coloring agent and ii) the spectral reflectance  $R_f$  of the second coloring agent. Each of these spectral reflectances can be obtained by measurement. See, for example, the specification at page 33, line 2 to page 33, line 18 and page 35, line 15 to page 36, line 11.

As discussed above, spectral reflectance is not discussed in WO 03/038001 or Hakamada. Therefore no "overlap" in ranges is shown or suggested. If this rejection is maintained, it is respectfully requested that the examiner identify the range of spectral reflectances allegedly shown in WO 03/038001 and Hakamada and how these ranges "overlap" what is required by claim 3. Claim 3 is submitted to be allowable for at least this reason.

Claim 4 depends from claim 3 and is submitted to be allowable for at least the same reasons as claim 3.

## CONCLUSION

Each issue raised in the Office Action dated June 2, 2006, has been addressed, and claims 1-4 and 10 are submitted to be in condition for allowance. Wherefore, reconsideration and allowance of claims 1-4 and 10 is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the examiner is respectfully requested to contact Scott Wakeman (Reg. No. 37,750)

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Reply to Office Action of June 2, 2006

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at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: August 30, 2006

Respectfully submitted,

By

  
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